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Dkt. #655



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Shawn Shui-on LEUNG
U.S. Serial No. : 09/892,613 Examiner: Larry Ronald Helms
Filing Date : June 27, 2001 Art Unit: 1642
For : REDUCING IMMUNOGENICITIES OF
IMMUNOGLOBULINS BY FRAMEWORK-PATCHING

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October 16, 2002

Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

COMMUNICATION IN RESPONSE TO
THE SEPTEMBER 16, 2002 OFFICE ACTION

This Communication is submitted in response to the September 16, 2002 Office Action issued by the United States Patent and Trademark Office in connection with the above-identified application. A response to the September 16, 2002 Office Action is due October 16, 2002. Therefore, this Amendment is being timely filed.

RESPONSE TO THE RESTRICTION REQUIREMENT

The Examiner to whom the application has been assigned has restricted the invention into five groups. Applicant respectfully traverses the above restriction requirement. In response, Applicant would like to elect Group I, directed to claims 1-13 and 16-19 for further prosecution of the application.

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However, inventions are not Independent under MPEP §806.04(A). The Examiner has stated restriction is proper because "[I]nventions I and I-III are distinct." To justify this position, he states, quoting MPEP §806.05(f), that the inventions are unrelated if the processes as claimed "cannot be used to make other and materially different product **and** cannot be made by another and materially different process," (emphasis added.)

Also, the Examiner has stated restriction is proper because "Inventions I and IV-V are distinct." To justify this position, he states, quoting MPEP §806.05(f), that the inventions are unrelated if the processes as claimed "cannot be used to make other and materially different product **and** cannot be made by another and materially different process," (Emphasis added.) he states, quoting §806.05(h), that the inventions are unrelated if "the process for using the product as claimed cannot be practiced with another materially different product **and** the product as claimed can be used in a materially different process of using that product. (Emphasis added). After stating this, the Examiner does not provide any factual evidence that the inventions (1) are incapable of use together or (2) have different modes of operation, function or effect.

Instead, he states "the inventions have acquired separate status" and have "recognized divergent subject matter and different classifications, restriction for examination purposes." These statements are not evidence of the inventions being incapable of use together and having different modes of operation, function or effect. Indeed, all of the present re-engineered antibody are capable of use

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together and have connected modes of operation, function and effect.

In conclusion, the Examiner has failed to meet either prong of the two-part showing required under MPEP §806.0(f) and (h) for independent inventions, and therefore restriction between Groups I, II, III, IV, and V is improper.

The Examiner has not, and cannot, demonstrate a "serious burden" because a single search can be done for all five Groups. A search for a re-engineered antibody, a search for Group I, would reveal references for methods of constructing a re-engineered antibody (Group II and Group III) and methods of treatment using the re-engineered antibody (Group IV and Group V). Applicant respectfully contends that the Examiner has not demonstrated "a serious burden." Therefore, Applicant requests reconsideration and withdrawal of the present restriction requirement.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

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No fee is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required, authorization is given to charge the amount of any such fee to Deposit Account No. 50-1891.

Respectfully submitted,

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I hereby certify that this paper is being deposited this date with the U.S. Postal Service with sufficient postage for first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.	
<u>Albert Wai Kit Chan</u>	<u>10/16/02</u>
Albert Wai-Kit Chan Reg. No. 36,479	Date